

REMARKS

Applicants respectfully request reconsideration. Claims 44 and 96 were previously pending in this application. By this amendment, Applicants cancel claims 44 and 96 without prejudice or disclaimer, and add claims 116-124. As a result, claims 116-124 are pending for examination, all of which are independent claims. No new matter has been added.

Applicants expressly reserve the right to file claims 44 and 96 in a continuing application.

1. Objections to the Drawings are Overcome

In response to the objections to the drawing under 37 C.F.R. §1.84(p)(5), Applicants have added a description of Fig. 8 to the specification on page 80, as illustrated above. This added description is clearly supported by Figs. 7 and 8 and in the specification on page 80, lines 10-15. No new matter has been added.

In view of the foregoing, Applicants respectfully request that the objections to the drawings be withdrawn.

2. Added Claims 116-124 Patentably Distinguish Over the Art of Record

Applicants respectfully submit that claims 116-124 patentably distinguish over the art of record, including U.S. Patent No. 5,541,638 (Story) and U.S. Patent No. 5,600,364 (Hendricks).

This application claims priority to U.S. Patent Application Serial No. 09/028,024, which issued as U.S. Patent No. 6,020,883, which claims priority to U.S. Patent Application Serial No. 08/346,425, which issued as U.S. Patent No. 5,758,257 (the '257 patent).

The '257 patent was the subject of two related law suits between the Assignee, Pinpoint, Inc., and Amazon.Com, Inc., et al. (Pinpoint, Inc. v. Amazon.com, Inc., et al., U.S. Dist. Ct. Northern Dist. of IL, Case Nos. 1:03-cv-04954 and 1:05-cv-01330). The docket reports for these suits are enclosed.

In the second suit (Case No. 1:05-cv-01330 (the '330 case)), the court issued an Opinion (Item No. 76 on the docket report) on claim construction for claims of the '257 patent, including claims 17, 41 and 43. Applicants respectfully disagree, to at least some extent, with the construction of claims 17, 41 and 43 set forth in the Opinion.

Newly added claims 116-124 are derived, to at least some extent, from claims 17, 41 and 43 of the '257 patent. Applicants intend these claims to have claim constructions different than those afforded claims 17, 41 and 43 in the Opinion, at least in part.

Applicants will submit the Opinion from the '330 case in an Information Disclosure Statement, along with other material information from the two law suits. **Applicants strongly suggest that the Examiner wait until this Information Disclosure Statement is filed before examining the claims currently pending in this examination.**

If there is any particular document listed on either of the enclosed docket reports that the Examiner would like to consider, Applicants respectfully request that the Examiner contact Applicants' representatives to request the document(s) or indicate the request in an official communication.

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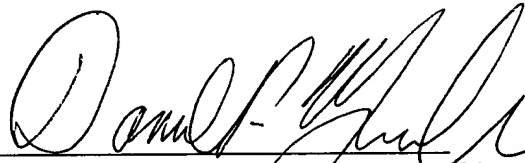
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Herz et al., Applicants

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